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OCT 13 2006**REMARKS

Withdrawn Claims 40-52 are cancelled. Claims 27 and 39 are amended. Support for the amendment to Claim 27 is found throughout the specification and in the Abstract and Field of Invention. The amendment to Claim 39 is to correct a minor typographical error. Claims 53-65 are new. Support for new Claim 53 is found at page 4, lines 23-24 of the originally filed application. Support for new Claims 54 and 56 is found at page 4, lines 23-24 of the originally filed application. Support for new Claim 55 is found at page 5, lines 14-16 of the originally filed application. Support for new Claim 57 is found at originally filed Figures 1-3 wherein the holdout layer (12) contacts at least a portion of the base layer (10). Support for new Claim 58 is found at page 4, lines 16-18 of the originally filed application. Support for new Claim 59 is found at page 5, lines 10-11 of the originally filed application. Support for new Claims 60-62 is found at page 7, lines 1-11 of the originally filed application. Support for new Claim 63 is found at original Claim 1. Support for new Claim 64 is found at page 4, line 28 to page 5, line 3, of the originally filed application. Support for new Claim 65 is found at page 10, lines 5-7 of the originally filed application. No new matter is believed to be introduced by the above amendment.

At the present time, Claims 27-39 and 53-65 are pending. Claims 32, 35, and 36 are withdrawn.

Applicants thank Examiner Cameron for her helpful comments in explaining the rejections in the outstanding Office Action. Applicants note that Examiner Cameron has only rejected Claim 28 under an obviousness double patenting rejection. It should be noted that Applicants file the required Terminal Disclaimer herewith this Response. Therefore, it appears as if Claim 28 would now be allowable over the references of record. Again, Applicants thank Examiner Cameron for her help with this matter.

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In addition, Applicants thank Examiner Cameron for indicating that the specification provides written description for supporting claims to a paper or paperboard that has a basis weight of greater than about 80 pounds per 3000 square feet (see the outstanding Office Action at page 4, lines 1-3). Accordingly, Applicants have amended independent Claim 27 to be drawn, in part, to a paper or paperboard that has a basis weight of greater than about 80 pounds per 3000 square feet.

The rejection of Claims 27, 29-31, 33-34 and 37-39 under 35 U.S.C. § 112, first paragraph, is believed to be obviated by the amendment above. Applicants have amended independent Claim 27 in accordance with the Examiner's suggestion in the outstanding Office Action at page 4, lines 1-3. Accordingly, Applicants respectfully request withdrawal of this ground of rejection.

The rejection of Claim 39 under 35 U.S.C. § 112, second paragraph, is believed to be obviated by cancellation of the word "material". Accordingly, Applicants respectfully request withdrawal of this ground of rejection.

The rejection of Claims 27-28, 31, 37, and 39 under the judicially created doctrine of obviousness type double patenting over claims 1-4 of US6,645,642 is believed to be obviated by the filing of the attached Terminal Disclaimer. Accordingly, Applicants respectfully request withdrawal of this ground of rejection.

The rejection of Claims 29 and 30 under 35 U.S.C. § 112, first paragraph, is traversed below. The Office is taking the position that the limitation stating that "the ink receptive layer, or a portion thereof, and the base layer, or a portion thereof, is not in contact" is not supported by the specification as originally filed. Applicants respectfully disagree on the basis that Figures 1-3 clearly depict that an embodiment of the invention in which the ink receptive layer (symbol 12, 14, or 16 in Figs 1-3), or a portion thereof, and the base layer

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(symbol 10 in Figs 1-3), or a portion thereof, are not in contact. The standard for satisfying written description requirements under 35 U.S.C. § 112, first paragraph is "does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed." *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Under *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). See MPEP section 2163.02. Possession may be shown in a variety of ways including description of an actual reduction to practice, or by showing that the invention was "ready for patenting" such as by the disclosure of drawings or structural chemical formulas that show that the invention was complete, or by describing distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention. See, e.g., *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998); *Regents of the University of California v. Eli Lilly*, 119 F.3d 1559, 1568, 43 USPQ2d 1398, 1406 (Fed. Cir. 1997); *Amgen, Inc. v. Chugai Pharmaceutical*, 927 F.2d 1200, 1206, 18 USPQ2d 1016, 1021 (Fed. Cir. 1991). See MPEP section 2163.02.

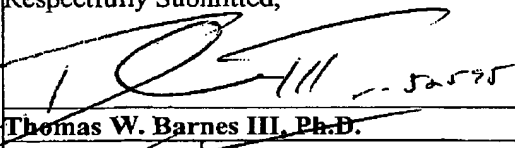
In the present situation, the invention is shown as ready for patenting by the disclosure of the originally filed drawings, which satisfies the legal objective standard for positively demonstrating acceptable written description requirements under 35 U.S.C. § 112, first paragraph. Therefore, the Office's position contradicts all of the above-mentioned case law cited by MPEP section 2163.02. Accordingly, Applicants respectfully request this ground of rejection to be withdrawn.

Applicants respectfully re-submit that, should the elected species be found allowable, the Office should expand its search to the non-elected species. Applicants maintain the Restriction Requirement and Election of Species traversal.

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Applicants further submit that this application is in condition for allowance on the merits and an early notification to that effect is earnestly solicited.

Please charge the amount of **\$120.00** required for any request for extension of time to our Deposit Account No. 09-0525. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 09-0525. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time.

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